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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,112	11/13/2003	Mitsumasa Tsuchiya	019519-409	7708
21839	7590	05/04/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			LE, HOA VAN	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	

1752

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,112

Applicant(s)

TSUCHIYA ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24(broadest), 17-21 and 23 with respect to the elect and applied species is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 17-21, 23 and 24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. 09/901,676.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

This is in response to Papers filed on 04 April 2005.

I. The record shows that applicants elects compound Y-1 species. The elected species has been considered and searched. The consideration and search are extended to the applied species being read within the general formula (I-B). Others has not been considered or searched until all of the elected and applied species are overcome.

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24(broadest), 18 and 21, are rejected under 35 U.S.C. 102(b) as being anticipated by Tanka et al (4,820,621).

Tanka et al disclose and teach an alkaline aqueous developing composition comprising a sufficient amount of compounds being read within the general formula (I-B) as claimed. Please see the whole disclosure of each of the applied reference, especially at col. 2:46 to 3:13, 38-37, 47.

Tanka et al do not specify “an electrical conductance...” as that in claim 21. Tanka et al disclose and teach the use of up to 5 g/l the strong charge tetramethyl ammonium hydroxide in the aqueous composition. It is reasonable that the aqueous has “an electrical conductance...” as claimed. The language “electrical conductance...” is a property of a material. It is allowed to

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request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim in accordance with the authority as stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Tanka et al are reasonable disclose and teach the claimed embodiments, claims 24(broadest), 18 and 21 are found to be anticipated by Tank et al.

III. Claims 24(broadest), 17-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al (5,532,116).

Suzuki et al disclose and teach an alkaline aqueous developing composition comprising up to 10 wt% of compounds being read within the general formula (I-B) as claimed. Please see the whole disclosure of each of the applied reference, especially at col. 4:29-33, 37-39, 17:60-64, 18:6 and 20:55-65.

Suzuki et al do not specify "to a divalent metal" as that in claim 20. Tanka et al disclose and teach the use of a chelating agent. It is reasonable that the known chelating agent in the art is able to chelate a divalent metal as claimed. The language "...to a divalent metal" is a property of a material. It is allowed to request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim in accordance with the authority as stated in *In re Schreiber*, 44 USPQ2d 1429.

Suzuki et al do not specify "an electrical conductance..." as that in claim 21. Tanka et al disclose and teach the use of about 90 g/l the strong charge sodium carbonate and sodium bicarbonate in the aqueous composition. It is reasonable that the aqueous has "an electrical conductance..." as claimed. The language "electrical conductance..." is a property of a material.

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It is allowed to request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim.

Since Suzuki et al are reasonable disclose and teach the claimed embodiments, claims 24(broadest), 17- 21 and 23 are found to be anticipated by Suzuki et al.

IV. Applicant's arguments filed 04 April 2005 have been fully considered but they are not persuasive.

Applicants state that they have canceled the applied species and formula (I-A) on the record. It results in the withdrawal of the applied references. The above applied references are new from a new search.

V. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
01 May 2005

HOA VAN LE
PRIMARY EXAMINER

